

REMARKS

In accordance with the foregoing, claims 1, 25, and 27 are amended to correct formalities. Claims 2, 5, 8, 10, 12, 14, 17, 19, 21, 24, and 26 are cancelled herein without prejudice or disclaimer. No new matter is presented, and accordingly approval and entry of the foregoing are respectfully requested.

Claims 1, 3-4, 6-7, 9, 11, 13, 15-16, 18, 20, 22-23, 25, and 27-42 are pending and under consideration. Reconsideration is requested.

I. Current Office Action Is Incomplete

Although the Office Action Summary indicates that claims 28-29 are rejected, the Detailed Action of the current Office Action does not include any support for a rejection of claims 28-29.

Applicants submit that the current Office Action is incomplete. Applicants request that if claims 28-29 are not found allowable that a replacement, nonfinal Office Action be issued with support for a rejection of the same, and with the response date accordingly reset.

II. Traverse of Rejections of claims 1, 3-4, 6-7, 9, 11, 13, 15-16, 18, 20, 22-23, 25, 27, and 30-42 under §103

In items 3-8 of the Office Action, the Examiner rejects claims 1, 3-4, 6-7, 9, 11, 13, 15, 25, 27, and 30-33 under 35 U.S.C. §103(a) as being unpatentable over Takizawa et al. (U.S.P. 5,739,596) in view of Pole, II et al. (U.S.P. 6,272,642). (Action at pages 2-5). In items 9-10 of the Office Action, the Examiner rejects dependent claims 16, 18, 20, 22-23 and 34-42 under 35 U.S.C. §103(a) as being unpatentable over Takizawa in view of Pole and Dunstan (U.S.P. 5,600,230). (Action at pages 5-7). The rejections are traversed.

***Prima Facie* Obviousness Not Established - Examiner's Assertion of Inherent Feature is Not Supported**

In item 13 of the Office Action, entitled Response To Arguments, the Examiner asserts:

amended language, "when the part of the mounted batteries is removed" to the claims 1 . . . and 25 . . . 27 was considered as an inherent feature of the previous claim and does not add anything to the scope of the invention as presented and considered earlier. . . . Takizawa and Pole in combination teach an apparatus that transition to a lower power processing ability when a part of the mounted batteries is removed from the apparatus.

(Emphasis added, Action at page 8-9).

Applicants submit that Examiner's assertion in support of the rejection that "when the part of the mounted batteries is removed" is an "inherent feature of the previous claim and does not add anything to the scope of the invention as presented and considered earlier," is not

supported.

As set forth, for example, in MPEP §2112:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

The Examiner has not provided any basis in fact and/or technical reasoning that the removal of the part of the mounted batteries is an inherent feature.

Applicants point out that claim 1, for example, recites an apparatus including "lowering the processing ability when the part of the mounted batteries is removed, while keeping the electronic apparatus operative in accordance with a decision from said processing ability determination section that the electric power is only capable of maintaining a lowered processing ability."

However, claim 1 does not preclude a lowering of a processing ability, for example, "in accordance with a decision from said processing ability determination section," in which a part of the batteries is not removed. That is, for example, when the battery power of the mounted batteries is degraded.

Applicants submit that the Examiner has not established *prima facie* obviousness and request that if claims are not found allowable that a replacement, nonfinal Office Action be issued with the Examiner's support for the Examiner's assertion of inherency and with the response date accordingly reset.

***Prima Facie* Obviousness Not Established -Recited Features Not Taught By Arguendo Combination**

Applicants submit that *prima facie* obviousness is not established since features recited by each of the independent claims are not taught by the art relied on by the Examiner alone or in combination. Independent claim 1, for example, recites an electronic apparatus to which a plurality of batteries are detachably mounted, comprising:

a) "a removal requirement receipt section receiving a removal requirement for a part of the mounted batteries;" and

b) "a processing ability determination section responsive to the removal requirement for the part of the batteries from said removal requirement receipt section to determine whether a supplying possible electric power from the remaining batteries is an electric power capable of maintaining a processing ability or an electric power only capable of maintaining a lowered

processing ability (emphasis added);" and

c) "a processing ability control section lowering the processing ability when the part of the mounted batteries is removed, while keeping the electronic apparatus operative in accordance with a decision from said processing ability determination section that the electric power is only capable of maintaining a lowered processing ability." Claim 25 has a similar recitation.

The Examiner asserts that Takizawa teaches determining whether a "non-selected battery's (remaining battery's) charge level is sufficient." (Action at page 3, lines 5-6).

However, Applicants submit that Takizawa, alone or in combination, does not teach a "processing ability determination section," as recited by independent claims 1 and 25.

Claim 1, for example, recites a processing ability determination section responsive to the removal requirement for the part of the batteries from said removal requirement receipt section to determine "whether a supplying possible electric power from the remaining batteries is an electric power capable of maintaining a processing ability or an electric power only capable of maintaining a lowered processing ability (emphasis added)." Claim 25 has a similar recitation.

Takizawa does not teach a lowered processing ability, let alone, determining whether the supplying possible power from the remaining batteries is an electric power is capable of maintaining such a lowered processing ability.

Further, Pole does not teach a processing ability determination section, as recited by claims 1 and 25 for example. By contrast, Pole teaches a technique for switching between a high performance mode for using external power source such as AC adaptor and a low performance mode for using internal power source such as battery. That is, Pole does not teach a determination based solely on the power of battery and thus fails to teach or suggest a determining in response to a removal requirement for a battery, whether a supplying possible electronic power from the remaining batteries is an electric power capable of maintaining a processing ability or an electric power capable of maintaining a lowered processing ability," as recited by independent claims 1 and 25, for example.

Thus, even an *arguendo* combination of Takizawa and Pole does not teach a processing ability determination section.

Independent claim 3 recites an electronic apparatus to which a plurality of batteries are detachably mounted, comprising:

a) "a mounting and removal detection section detecting mounting and removal of

batteries;" and

b) "a processing ability control section responsive to a detection of a removal of a battery by said mounting and removal detection section to lower a processing ability when the part of the mounted batteries is removed while keeping the electronic apparatus operative." Claim 27 has a similar recitation.

Neither Takizawa nor Pole, alone or in combination, teach "lower(ing) a processing ability when the part of the mounted batteries is removed," as recited in claims 3 and 27

By contrast, Takizawa teaches a detection switch 14 (15) that is a switch for detecting opening/closing of the cover of a battery pack. Applicants submit that as understood in the art a switch for merely detecting a movement of a cover does not teach a switch for detecting the removal of a battery.

For example, one can open and close a cover without removing a battery. Further, a device can have uncovered batteries that can be removed.

By contrast, Pole merely teaches a removal of a battery means use of an external power. Therefore, even a combination of Takizawa and Pole includes a switch for detecting removal of a battery, Pole teaches that a processing ability is increased when the battery is removed, instead of being lowered, by switching to AC.

Prima Facie Obviousness Not Established: No Motivation To Modify Takizawa In A Manner As Suggested By Examiner

The Action concedes that Takizawa's does not:

lower the processing ability while keeping the electronic apparatus operative in accordance with a decision from determination section that the electric power needs to lower the processing ability . . . (nor) different modes of operation with different processing ability depending upon the available charge level determination of unselected battery.

(Action at page 3).

However, the Examiner asserts it would have been an obvious to modify Takizawa with Pole:

to include a transition to lower processing ability [lower performance state] in response to determination that low charge level instead of directly stop state . . . to trigger switching to a lower performance state if usage is low which obviously also lengthen the life of battery.

(Action at page 4).

The Examiner also asserts it would have been obvious to modify Takizawa and Pole with Dunstan:

to include Dunstan's smart battery with rechargeable battery, memory, and controller which calculates and updates remaining capacity value based on battery current, and battery's characteristics and periodically compares capacity alarm value and sends capacity alarm signal when remaining capacity value is less than the alarm value which controls its own charge cycle to optimize charge time, prolong battery life, and prevent destructive charging conditions too.

(Action at page 7).

Applicants submit there is no motivation to modify Takizawa to permit "lowering the processing ability when the part of the mounted batteries is removed," as recited by claim 1 for example, as the Examiner asserts.

By contrast, Takizawa is directed to a power supply and method that regardless of whether a battery pack is removed correctly or mistakenly teaches:

The circuit will therefore not misoperate even when battery pack 102 is . . . removed because circuit operation has already been stopped.

(Emphasis added, see, for example, 12, lines 20-23).

Takizawa is designed so as to either switch power sources or stop operation. As illustrated in Takizawa Fig. 6 "the power supply control process executed when one of the battery covers is opened according to the preferred embodiment of the invention (emphasis added)" and Fig. 8 that "describe the power supply control process executed when one of the battery covers is opened according to an alternative embodiment of the present invention," the power supply and method taught by Takizawa are designed to either "switch to other battery," (Steps S60 and S82) or "stop device operation" (Steps S62 and S84). (See, for example, Figs, 6 and 8 and col. 3, lines 40-53). That is, the device and method of Takizawa are designed based on these either/or operations.

In KSR International, the U.S. Supreme Court held that in determining obviousness, one also "must ask whether the improvement is more than the predictable use of prior art elements according to their established functions (emphasis added)" slip op. 13, 82 USPQ2d at 1396. Furthermore, it is necessary "to determine whether there was an apparent reason to combine the known elements in the fashion claimed" slip op. 14, 82 USPQ2d at 1396.

The Supreme Court further affirmed the KSR International holdings in *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006), stating: "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (Emphasis added).

Using the Examiner's logic each and every feature of Pole would have been obvious to modify into Takizawa if there was a possibility that it could somehow be done, regardless of the further modifications and experimentation and redesign of the rest of Takizawa to incorporate such asserted modifications. Applicants submit the Examiner's assertions are merely conclusory and do not support a finding of *prima facie* obviousness.

Summary

Since features recited by claims 1, 3-4, 6-7, 9, 11, 13, 15-16, 18, 20, 22-23, 25, 27, 30-42 are not taught by the cited art and *prima facie* obviousness is not established, the rejections should be withdrawn and claims 1, 3-4, 6-7, 9, 11, 13, 15-16, 18, 20, 22-23, 25, 27, 30-42 allowed. Applicants also submit that claims 28-29 should be allowed as there was no support at all for the rejection of the same.

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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